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Supreme Court of the United States

October Term, 1971

No. 71-363

BECKMAN INSTRUMENTS INCORPORATED,

Petitioner,

vs.

REEVES INSTRUMENT CORPORATION and DYNAMICS CORPORATION OF AMERICA,

Respondents.

RESPONDENTS' BRIEF OPPOSING PETITION FOR WRITS OF CERTIORARI AND/OR MANDAMUS

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Opinion Below

Omitted from petitioner's brief and reproduced in the Appendix hereto, are the Decision of the District Court filed June 7, 1968 (RA 1a);[1] and the Findings of Fact and Conclusions of Law entered on November 27, 1968 (RA 3a).

1. RA refers to respondents' appendix hereto.

The Findings are reported at 161 USPQ 450. The opinion of the Court of Appeals as modified on Denial of Rehearing, is reported at 444 F.2d 263.

Corrections to Statement of the Case

Petitioner's Statement is incomplete and inaccurate.

1. Contrary to petitioner's allegations (PB 6),[2] the Court of Appeals did not "ignore" the defense of anticipation. It considered and rejected it. (See A 18).[3]

2. Petitioner is wrong in asserting at PB 6 that the Court of Appeals "ignored" the defense of invalidity for "late-claiming". It correctly declined to *discuss* the defense (A 18) because petitioner failed to allege error in the District Court's findings thereon and because petitioner did not urge the defense in its brief on appeal (see p. 4, *infra*). While not discussing the defense, the Court of Appeals clearly ruled on it when it affirmed the District Court (A 4), and again when it denied (A 29), the Petition for a Rehearing which raised this very point (A 48). Moreover, it also discussed and rejected the main premise of the defense when it found the differences between the disclosed and accused structures to be "minor" (A 28).

3. Contrary to petitioner's allegation (PB 7), the application *as filed* did contain claims directed to static checking only, namely, application claims 5, 7 and 8.

2. Pages of petitioner's brief are referred to with the prefix PB.

3. Pages of petitioner's appendix are referred to with the prefix A.

4. Contrary to the assertion at PB 7, claim 10 of the application as filed, covering both static and dynamic checking, was *not* limited to the quoted means for disconnecting the output. Nor was the specification broadened as alleged at PB 7. The matter deleted by the amendment is plainly repetitious; its substance appears again, not only in the same sentence, but in the next sentence as well (RA 107a, column 4, lines 35-40), and elsewhere in the specification of the patent in suit.[4]

5. After hearing the testimony of Spencer who was questioned on the memorandum partially quoted at PB 8, the District Court rejected petitioner's alleged "reason for adding such new claims" (RA 87a).

6. The WADC reference to "proprietary information" (PB 8) was concerned with avoiding the disclosure of *secret data* because the data supplied might be disseminated to competitors in the specification of a "request for bid" (Findings E6, E7 at RA 22a).

7. Respondents do not recall that the alleged matters "overlooked" by the Court of Appeals (PB 8), were ever brought to that Court's attention. They cannot be found in petitioner's brief on appeal nor its reply brief.

8. The matter appearing under the caption "Subject Matter of the McCoy Patent In Suit" (PB 9) is hopelessly incomplete and inaccurate. The opinion of the Court of Appeals (A 4—A 31) and the Findings (RA 3a, *et seq.*) provide a complete description.

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4. *Id.*, column 4, lines 65 and 68; column 5, line 48.

ARGUMENT

1. The appellate court correctly declined to discuss late-claiming because petitioner failed to urge the defense in its brief on appeal and failed to allege error in the District Court's findings thereon.

Petitioner's primary case for the issuance of the writs proceeds from the charge that the Court of Appeals was derelict in its duty because it refused to consider or decide the "late claiming defense of invalidity".[5] The charge asserts that the Court "* * * departed from the accepted and usual course of judicial proceedings * * *"; and "* * * refused to honor [its duty]". These inflammatory accusations are both unfounded and ill-advised. It was petitioner's own failure to brief the defense or urge error in the District Court's findings rejecting the defense, which led to the statement in the appellate opinion that petitioner now attacks.[6]

To obscure this failure, petitioner has reproduced in its Appendix (A 32-35), what purports to be an excerpt from its "Brief for Appellant". The "excerpt" includes a single sentence hypothesizing invalidity for late-claiming at the top of page 34, and the citation of two late-claiming decisions at the bottom of page 35.

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5. It should be borne in mind that at the trial of this action, petitioner urged a late-claiming defense of non-infringement, rejected by both Courts below; the petition herein however is addressed solely to the "late-claiming defense of *invalidity*".

6. The statement is: "Other defenses, including late claiming, were urged before the district court but are not relied upon in this appeal and thus will not be discussed."

Artfully disguised is the fact that the statement on page 34 hypothesizing invalidity, is taken from the "STATEMENT OF THE CASE" section of petitioner's appeal brief, while all of the matter following thereafter, including the citation of the two late-claiming cases referred to above, is excerpted from the section of its brief, found seventeen pages later, *which argues non-infringement* under the caption"THE BECKMAN COMPUTERS DO NOT INFRINGE MCCOY '997"!

There is not a *single word* said about the defense in the listed arguments of petitioner's Topical Index, nor under the statement of "contentions of defendant Beckman", nor in any of the arguments on invalidity, nor in the conclusion. Parts of these sections are reproduced herein (RA 99a-104a).

The Court of Appeals was therefore correct in its observation that the late-claiming defense was "not relied upon in this appeal" (A 18).

It is true that respondents, in rebutting petitioner's late-claiming theory of *non-infringement,* made a passing reference to invalidity in their answering brief.[7] It is also true that this provoked a response in petitioner's Reply thereto. But the appellate tribunal cannot be faulted for not *discussing* an issue which petitioner did not deem worthy of inclusion in its Brief on Appeal.

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7. Note that Point 11 of respondents' answering brief, reproduced at A36, is directed to the issue of infringement. It should also be noted that Point 2, reproduced at A39, is under the caption, *not shown,* entitled "Infringement". Here, again, is an omission which "coincidentally" distorts the record in favor of petitioner's allegations.

2. The Court of Appeals did decide the late-claiming defense of invalidity.

The late-claiming defense of invalidity was urged by petitioner in the *trial* of this action. It was rejected by the Trial Court on a record which included testimony, the prosecution history of the patent, all other relevant documentary materials, and after extensive post-trial argument (R. 2146-2166, 2232-2239, 2294-2303). Findings on the subject were briefed, modified, argued, and finally adopted by the Trial Court I1-I20, RA 83a).

While the Court of Appeals declined to discuss the late-claiming defense for the reasons explained above, it unanimously affirmed the District Court's decision. Accordingly, the late-claiming defense of invalidity was, in fact, decided by the Court of Appeals for the Ninth Circuit.[8]

It was decided not once, but *twice*. When the Court of Appeals declined to discuss the defense, the petitioner Beckman petitioned the Court for a rehearing. While modifying its original opinion on other points raised in the rehearing petition, the appellate court denied the Petition for a Rehearing, thereby affirming for a *second time* the District Court's rejection of "late claiming".

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8. *Twist* v. *Prairie Oil*, 274 U.S. 684, cited in petitioner's brief is inapposite. There, the appellate court held that it lacked the power to rule on the assigned errors.

3. The Court of Appeals considered and rejected the substance of the late-claiming defense, (1) when it considered and rejected the basic premise of that defense, and (2) when it rejected that defense as a ground of non-infringement.

While the Court of Appeals did not discuss the late-claiming defense *in haec verba,* it thoroughly considered and rejected the basic premise upon which petitioner's late-claiming defense rests, namely, that there are material differences between the circuit *disclosed* in the patent and the circuit accused as an infringement. After a point-by-point comparison of these two structures, the appellate court concluded (as had the District Court) that the differences between them were "minor" (A 28). Since the original claims admittedly cover the disclosed circuit, they necessarily cover "minor" variations thereof, as well. Thus in considering and disposing of this threshold question, the Court did in fact and in substance consider and reject petitioner's late-claiming theory.

The alleged facts of late-claiming were asserted below as a ground in support of *non-infringement.* When the Court of Appeals took up the question of infringement and affirmed the District Court's decision, it again, in substance, considered and rejected the late-claiming defense.

Contrary to petitioner's allegations, the Court of Appeals discussed, considered, and twice decided its late-claiming defense. There are accordingly no grounds here for issuing either of the requested writs.

4. There is no late-claiming defense.

Petitioner, who is not only an adjudicated infringer, but who also was found to be a deliberate copier (Findings E33, E36, E37), pretends to be the spokesman for an allegedly victimized analog computer industry, the crusader for judicial reform of alleged late-claiming abuses,[9] and the protector of discoveries made by others (PB 14).[10] These roles are as absurd as the one assumed by petitioner in disguising itself as an outraged suitor misused at the hands of a derelict Court of Appeals.

As for the analog computer industry, the real victims are respondents, who are no longer in that business, in material measure, if not entirely, because of the deliberate and immediate pirating of respondents' invention by petitioner and others. That loss can never be compensated.

As for the alleged late-claiming abuse, it simply does not exist in this case. The record shows and the District Court found that the invention which is the subject matter of the claims in suit, was disclosed and claimed in the original application as filed, and continued to be claimed during the entire pendency of the application (I1).

9. Contrary to the innuendo of impropriety ascribed to it by petitioner, respondents' disclosure to WADC of the solution to the checking problem, when respondents could have treated the solution as a trade secret, was an act of generosity—the disclosure was made without any commitment by WADC to purchase respondents' computer.

10. It is incredible that petitioner can make this allegation in view of the record herein. After copying a first version of the invention "made in the light of the Reeves Problem Check system" (Finding E33), it copied EAI's version (Finding E36) which in turn was admitted by an officer of the latter to have been also derived from Reeves' system (E30).

The evidence supporting that finding is spelled out in detailed Findings I2 through I12 and includes the prosecution history of the patent and the testimony of B. F. Spencer. This analysis shows that "claims 7 and 8 * * * introduced no new matter but merely made express what would have been regarded as the equivalent of the subject matter set forth in original claim 2 of the application as filed * * *" (and) "* * * cover the same territory as that covered by [original] claims 1-6" (I10); "* * * are directed to the same invention as that * * * in original claim 2 * * * and are consonant with the objects and disclosures of the invention * * * as filed" (I12).

The findings on late-claiming also squarely meet and refute the petitioner's contention, reargued herein, that the claims in suit introduced for the first time, means for "measuring the test voltage at the input of the integrator" (PB 8). Not only did the Patent Office fail to question the support for claims 7, 8 and 13 (I15), it expressly ruled that such support existed: as pointed out in Findings I9 and I11, the Patent Office Examiner held that claims 20 and 21, having essentially this language, "cover the same territory as that covered by allowed claims 1-6 * * *" (Finding I9) and are "drawn to the operation of the apparatus disclosed or its equivalents * * *" (Finding I11).

Petitioner's late-claiming argument is no more than a rehash of contentions contradicted by the record and rejected below.

5. The correct test of invention was applied by the Court of Appeals.

The invention herein was tested by the Court of Appeals for the Ninth Circuit against the strict standards enunciated by this Court in *A&P, Deere* and *Black-Rock* and found to be patentable. Indeed, the appellate court's discussion of the applicable law on the question of obviousness is devoted exclusively to these three cases under the caption "The Applicable Standard" (A18-22).[11]

The Court, after noting the "numerous attempts" (A6) to solve the problem which "was born with the development of such computers and has since occupied much time and effort in the computer industry" (*ibid.*), and "which had plagued the computer industry since the development of complex analog computers" (A23), and after describing the failure of distinguished scientists and scientific institutions to solve this problem (A6, A21-A24), and after taking note of the enthusiastic reaction of the scientists at WADC when the solution was presented to them by McCoy (A 24), concluded that the differences between the claimed invention and the prior art "were not obvious to one of ordinary skill in the art, and did produce the unusual or surprising result referred to in *A&P supra*" (A 25, A 29).

11. Since the opinion of the Court of Appeals as reproduced in petitioner's appendix may be referred to in the discussion below, it should be noted that a line therein has been omitted. Following the word "obvious" at line 13, page 20, there should be inserted: "to one of ordinary skill in the art. The Court's more recent decisions". Also, the language "and did produce * * * *supra*", appearing at lines 5 and 6 of page 25 of the appendix, was not in the original opinion but was added thereto in the denial of the Petition for a Rehearing. (See A29-A31 where all of the amendments appear)

This finding that the invention produced unusual or surprising results is tantamount to a finding of a "synergistic effect", a finding that "two plus two equals more than four" (*Great Atlantic and Pacific Tea Company* v. *Supermarket Equipment Corp.,* 340 U.S. 147; 71 S.Ct. 127; 95 L.Ed. 162 at 340 U.S. 152). It is also a finding of that kind of unorthodoxy, that kind of success against a history of failures, and that kind of subsequent acclaim, which persuaded this Court that the invention of Adams was patentable, *United States* v. *Adams,* 383 U.S. 39; 86 S.Ct. 708 (1966).

While the word "synergistic", *in haec verba* is not found, the opinion as a whole eloquently describes this effect. The finding that the invention solved *simultaneously* both the problems of *incompleteness* and *disturbance* (A6, A13-A15, A17, A18, A23, also Findings D1-D4, D13, D14, H1), is in substance a finding of a startling synergistic effect and especially so when, as was found here, these accomplishments were wrought with simple instrumentalities (A25). To check *more* elements with *less* disturbance is intrinsically synergistic.

These findings of the Court of Appeals are fully supported in turn by the District Court findings. To utilize in the claimed combination the summing junction input, which is the most easily disturbed portion of the computer (D7, D8 and D9), and end up with a non-disturbing measurement (D1-D4, D9, H1, H11) is, we submit, synergism of the highest order. It is also highly unorthodox (D8, D9) and thus comports with the indicium of invention found to be particularly persuasive in *United States* v. *Adams, supra.* The new checking role played by the summing junction input as described in these findings (D7-D9,

[illegible] and in the appellate opinion (A8-A10, A18, A21), also refutes entirely petitioner's complaint that it cannot find in the record below any new functions performed by the elements of the claimed combination.

There is no aggregation in this case and there is ample evidence of a synergistic effect. The Court of Appeals hewed strictly to the standards enunciated by this Court in *Adv. Deere, Adams* and *Black-Rock*. The opinion of the Court of Appeals is not contrary to the constitutional standards of patentability nor is it in conflict with the decisions of this Court, the Ninth Circuit or other circuits.[12] There are no grounds for the issuance of the writ of certiorari.

Conclusion

There are no grounds in support of the requested writs. The late-claiming defense has been decided and is without merit. Patentability has been conscientiously measured in both Courts below against the strict constitutional standards enunciated by this Court. The correct law has been followed, there are no conflicts, and justice has been rendered. The petition should be denied.

Respectfully submitted,

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12 In contrast, if petitioner's theory were adopted, a great deal of confusion and conflict would arise among these decisions.